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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/784,485 | 02/20/2004 | Michael L. Howard | 2291.2.9.2 | 2179 |

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| EXAMINER | |
|---|---|
| NGUYEN, TANH Q | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2182 | |

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/784,485 | HOWARD ET AL. | |
| | Examiner | Art Unit | |
| | Tanh Q. Nguyen | 2182 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *20 February 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *05/26/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Specification*

1. The current status of the parent application needs to be updated with the actual U.S. patent number.

### *Claim Objections*

2. Claims 1-15 are objected to because of the following informalities: claim 1 recites, "to receive new data...to update the adapter" in lines 9-10. It appears that applicant meant to recite "to receive new data...to update a program of the adapter". Claims 8, 13, 15 recite similar limitations, and are objected on the same basis.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3, 5-7, 13, 15 are rejected under 35 U.S.C. 102(a)/102(e) as being anticipated by Cole et al. (US 6,074,434).

5. As per claims 1, 3, 5-7, Cole teaches a communications adapter [client 14, FIG.

2] for facilitating electronic communications with an electronic device [i.e. a peripheral device of client 14] wherein the adapter is remotely reprogrammable by a provider computer [servers 12, 17 - FIG. 2; col. 12, lines 16-18] through a communications network [20, FIG. 1; col. 3, lines 16-19], the adapter comprising:

a communications port for electronically connecting the adapter to the electronic device [communications port inherent for electronically connecting a client to a peripheral device];

communications hardware [modem, col. 3, lines 19-24] for communicating with the provider computer through the communications network;

a processor [inherent in a client]; and

memory [32, 33, 34, 39 -FIG. 2; col. 3, lines 57-60] programmed to cause the adapter to send an identification of the adapter to the provider computer via the communications network [col. 4, lines 36-39] and to receive new data sent by the provider computer via the communications network to update a program of the adapter [col. 7, lines 8-15], wherein the new data comprises device instructions for the processor for communicating with the electronic device through the communications port[col. 5, lines 13-17].

Cole further teaches the communications network being the Internet [col. 3, lines 16-19], hence a global communications network;

the new data being device driver [col. 5, lines 13-17], hence the new data comprising a translator that includes and object representation [e.g. ABCDE.DRV] / functional representation [a device driver] of the electronic device;

the memory further programmed to cause the adapter to identify the electronic device and to further send an identification of the electronic device to the provider computer via the communications network [client identifies device drivers and sending list of updates for device drivers - col. 6, line 50-col. 7, line 11; alternatively for a peripheral device that is not likely to change often, the information about such peripheral device is sent to the provider computer - col. 4, lines 31-39].

As per claim 13, the claim generally corresponds to claim 1, with the electronic device having an external communications port [peripheral device of a client having an external communications port], and the adapter establishing communications with the provider computer [col. 3, lines 62-64]. Claim 13 is therefore rejected on the same basis as claim 1.

6. As per claim 15, the claim generally corresponds to claim 1 with the new instructions being used for communicating with the electronic device without altering any program code on the electronic device [Cole teaches updating a driver on the client and does not teach altering any code on a peripheral device]. Claim 15 is therefore rejected on the same basis as claim 1.

### *Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 2, 4-6, 8-12, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cole et al..

10. As per claims 2, 4, 8-12, 14, Cole above teaches the invention except for a wireless link between the provider computer and the adapter, the communications network being a pager network, or a cellular network. Since applicant admitted that the type of communications network is not significant and any type of communications network capable of facilitating communications between the adapter and the provider computer may be utilized [page 5, lines 6-11], it would have been obvious to one of ordinary skill in the art at the time the invention was made to practice the claimed invention with a pager network, or a cellular network - hence a wireless link between the provider computer and the adapter, in order to facilitate communications between the adapter and the provider computer.

11. As per claims 5-6, 10-11, since it was known in the art at the time the invention

was made for a client to include a translator with object representation or functional representation to provide protocol translation for proper communications with the peripheral devices, it would alternatively have been obvious to one of ordinary skill in the art at the time the invention was made for the new data to comprise a translator, in order to provide proper communications with the peripheral devices.

***Double Patenting***

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In *re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,954,850.

As per claims 1-2, 8-9, 13-15, claim 1 of U.S. Patent No. 6,954,850 claims all the elements/steps of claims.

As per claims 3-4, since applicant admitted that the type of communications network is not significant and any type of communications network capable of facilitating communications between the adapter and the provider computer may be utilized [page 5, lines 6-11], it would have been obvious to one of ordinary skill in the art at the time the invention was made to practice the claimed invention in a global communications network, instead of a pager network.

As per claims 5-6, 10-11, since it was known in the art at the time the invention was made for a communications adapter to include a translator with object representation or functional representation to provide protocol translation for proper communications between devices, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the new data to comprise a translator, in order to provide proper communications between the devices.

As per claims 7, 12, since it was known in the art at the time the invention was made for a communications adapter to identify an electronic device coupled to the communications adapter and send an identification of the device to a provider computer in order for the communications adapter to provide proper update and protocol translation, it would have been obvious to one of ordinary skill in the art at the time the invention was made to identify the electronic device and send the information to the provider computer in order for the communications adapter to provide proper update and protocol translation.

14. Claims 1-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,728,804, in view

of Cole et al..

Claims 1-15 of U.S. Patent No. 6,728,804 claims all the elements/steps of claims 1-15 of the instant application except for the adapter sending an identification of the adapter to the provider computer to update a program of the adapter.

Cole teaches an adapter sending an identification of the adapter to the provider computer to use the identification to determine what updates are appropriate for the update of a program of the adapter [see 102 rejections above]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to send an identification of the adapter, as is taught by Cole, in order to determine what updates are appropriate for the update of a program of the adapter.

15. Claims 1-15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/176,140 in view of Cole et al..

As per claim 1, claim 1 of copending Application No. 11/176,140 claims all the elements of claim 1 of the instant application except for the adapter sending an identification of the adapter to the provider computer to update a program of the adapter. Cole teaches an adapter sending an identification of the adapter to the provider computer to use the identification to determine what updates are appropriate for the update of a program of the adapter [see 102 rejections above]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to send an identification of the adapter to the provider computer, as is taught by Cole, in

order to determine what updates are appropriate for the update of a program of the adapter.

As per claims 2-15, see the 102/103 rejections with respect to Cole above.

***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tanh Quang Nguyen whose telephone number is (571) 272-4154 and whose e-mail address is tanh.nguyen36@uspto.gov. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh, can be reached on (571) 272-4147. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for After Final, Official, and Customer Services, or (571) 273-4154 for Draft to the Examiner (please label "PROPOSED" or "DRAFT").

Effective May 1, 2003 are new mailing address is:

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04/15/2006

TQN
April 15, 2006